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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,577	07/06/2001	Tatsushi Hakuchoh	JP920000097US1	4077

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EXAMINER

LOHN, JOSHUA A

ART UNIT	PAPER NUMBER
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2114

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/900,577	<b>Applicant(s)</b> HAKUCHOH ET AL.	
	<b>Examiner</b> Joshua A Lohn	<b>Art Unit</b> 2114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,7,9 and 10 is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,8 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 10/12/2004 have been fully considered but they are not fully persuasive.

With respect to applicant's arguments regarding claims 2, 3, 5, 8, 11, 12, 13, 14, and 15 that Carbonneau et al. fails to disclose "recognizing said connection with said other device in response to receipt of a reply by said outside device to a predetermined command by said circuit portion", the examiner respectfully disagrees. Carbonneau et al. discloses the predetermined command by the said circuit portion in the form of the initiation of the test phase in the CMAC and discloses the recognition of the connection in the completion of the verification operation that is in response to the command (Carbonneau et al., col. 16, line 66 through col. 20, line 15). Carbonneau discloses this and all other limitations of the claims, as is described in detail in the rejection that follows.

Applicant's arguments with respect to claim 6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

Claims 4, 7, 9, and 10 are allowable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 2, 3, 5, 8, and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Carbonneau et al., United States Patent 5,835,700, Published November 10, 1998.

As per claim 2, Carbonneau discloses a method for controlling a start-up operation of a unit having at least a circuit portion and being connectable to an outside device (Carbonneau, col. 19, lines 56-57, where the CMAC board begins operation at startup and is connected to an outside device, col. 14, lines 49-51). Carbonneau further discloses the method including executing a first self-checking test when a connection between the outside device and the circuit portion is not recognized (Carbonneau, col. 12, lines 53-57, shows the test system includes diagnostic software that is operable without an outside device connection, and these first self-checking tests are executed periodically, col. 5, lines 4-10). Carbonneau also discloses executing a second self-checking test including at least a part of said first self-checking test, when the connection between the outside device and the circuit portion is recognized (Carbonneau, col. 14, lines 49-63, where the second self-checking test is a test which is initiated remotely by an outside device, this test uses the same code as the first self-checking test and would be included within it). Carbonneau further discloses recognizing said connection with said other device in response to receipt of a reply by said outside device to a predetermined command by said circuit portion (Carbonneau, col. 19, line 66 through col. 20, line 15, where the predetermined command is the

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initiation of the test phase by the CMAC, and the completed verification will recognize the connection following the command execution).

As per claim 3, Carbonneau further discloses that the command and reply are communicated between the outside device and the circuit portion through an interface (Carbonneau, col. 7, lines 16-23, where the host-to-network interface module is used in communication).

As per claim 5, Carbonneau further discloses that the execution of the second self-checking test includes wherein said outside device is used for making a test or adjustment in a process of analyzing a failure of the unit (Carbonneau, col. 14, line 49 through col. 15, line 10).

As per claim 8, Carbonneau discloses a control board, which is combined with a mechanical part for performing a predetermined operation and stores a program for controlling the mechanical part (Carbonneau, col. 9, lines 59-65, where the mechanical part is a SCSI bus, and the control board is the CMAC board, which includes a controlling program, col. 12, lines 52-65). Carbonneau also discloses an interface for communicating data between the control board and an outside device (Carbonneau, col. 7, lines 16-23, where the host-to-network interface module is used in communication). Carbonneau further discloses wherein the program includes one or more types of self-checking test programs (Carbonneau, col. 16, lines 32-64, where one type is used in event of a fatal error and another type is used normally), and also includes a process of outputting a predetermined command to the outside device through the interface (Carbonneau, col. 19, line 63 through column 20, line 15, where the predetermined command is the data path check). Carbonneau also discloses a process of selecting and

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executing a specific self-checking test program from the one or more types of self-checking test programs in accordance with a control command input from the outside device through the interface in response to the predetermined command (Carbonneau, col. 14, lines 44-67, where the commands are executed based upon communication from outside device).

As per claim 11, Carbonneau discloses an input-output port, which is employed at a time of debugging a program, as the interface (Carbonneau, col. 7, lines 16-23, where the host-to-network interface module is used in communication to provide input and output data transactions).

As per claim 12, Carbonneau discloses a mechanical part for performing a predetermined operation, and a control section for controlling the mechanical part (Carbonneau, col. 9, lines 59-65, where the mechanical part is a SCSI bus, and the control board is the CMAC board), wherein said control section includes means for transmitting a predetermined command from said unit to recognize said connection, and ascertaining receipt of a control command output from said outside device in response to whether said predetermined command is detected (Carbonneau, col. 19, line 66 through col. 20, line 15, where the predetermined command is the initiation of the test phase by the CMAC, and the completed verification will recognize the connection following the predetermined command execution). Carbonneau further discloses the control section comprises a storage unit for storing one or more types of self-checking test programs (Carbonneau, col. 12, lines 52-65) which are executed at a time of starting operation (Carbonneau, col. 19, lines 56-67). Carbonneau discloses a notification unit for informing an outside device at a predetermined time that a command is acceptable (Carbonneau, col. 20, lines 1-15, where the data path integrity

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test will notify the unit when data transactions are acceptable). Carbonneau discloses a selection means for selecting a self-checking test program which is executed, from among plural kinds of said self-checking test programs, based on whether or not there is a control command input from the outside device in response to the notification by said notification unit (Carbonneau, col. 5, lines 4-10, where some tests are periodic and need no outside device, and col. 14, lines 49-60, where other tests are initiated by an outside device). Carbonneau discloses an execution unit for executing the self-checking test programs selected by the selection unit (Carbonneau, col. 10, lines 20-24, where the CMAC board acts as an execution unit).

As per claim 13, Carbonneau discloses the device according to claim 12, which is a tape drive unit for reading out or writing data from or to a tape, which is a storage medium (col. 20, lines 56-57, where the devices being controlled can include a tape drive unit).

As per claim 14, Carbonneau discloses a system for checking a product in a process of fabricating the product (Carbonneau, col. 16, line 58 through col. 17, line 15, where the fabrication is the determination of final working configuration, such as removal of failed drives to make working system and the checking system detects the faulty drives). Carbonneau further discloses the system being equipped with a moving part and a control section for controlling the moving part (Carbonneau, col. 9, lines 59-65, control section is CMAC board and moving part is the SCSI drive attached to the bus). Carbonneau also discloses a command, for shifting a checking process to a predetermined self-checking test, is output from the checking system, connected to the product fabricated to an extent having at least the control section, when the checking system is notified by the product that a command is acceptable (Carbonneau, col. 19,

line 63 through col. 20, line 15, where CMAC determines the command is acceptable through data path testing, and is able to change to executing the various testing processes).

As per claim 15, Carbonneau discloses the checking system according to claim 14, wherein the predetermined check is made for said product given a predetermined self-checking test in response to said command output from said checking system (col. 14, lines 49-67, the remote device acts as the checking system to execute a predetermined self-checking test).

2. Claim 6 rejected under 35 U.S.C. 102(e) as being anticipated by Fister et al., United States Patent no. 6,324,657, filed June 11, 1998.

As per claim 6, Fister discloses a method for executing a self-checking test where a first step of executing a test common to a first self-checking test, which is executed when said unit is in a finished-product state (Fister, col. 1, lines 19-21, where the first test is the test at boot, where it is inherent that the system is in a finished state), and a second self-checking test, which is executed when said unit is in an unfinished-product state prior to initial deployment and use (Fister, col. 1, lines 17-18, where the second test is the test during wafer production or packaging, where it is inherent that the system is in an unfinished state); a second step of judging whether said unit is in said finished-product state (Fister, col. 1, lines 17-21, where the judging is inherent in determining that the device is finished and not still in production); and a third step of continuing one of the set of said first self-checking test, or said second self-checking test, based on said judgment in said second step (Fister, col. 1, lines 19-21, where the first test will be executed at every boot operation judgment).



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua A Lohn whose telephone number is (571) 272-3661. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571) 272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAL



**SCOTT BADERMAN**  
**PRIMARY EXAMINER**